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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,755	05/16/2006	Ralf Schmeling	18213	1610
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CNH AMERICA LLC INTELLECTUAL PROPERTY LAW DEPARTMENT PO BOX 1895, M.S. 641 NEW HOLLAND, PA 17557			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 06/25/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,755

Applicant(s)

SCHMELING ET AL.

Examiner

VICTOR MACARTHUR

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 6-13 are objected to because of the following informalities:

The term “borne” is recited throughout the claims in a manner inconsistent with its commonly accepted meaning of “transported or transmitted by”. For instance, how is applicant's “third component borne [transported or transmitted by] on at least one outer end of the pin” (lines 11-12 of claim 6)? How are “the first component and the second component... both borne [transported or transmitted by] alongside each other” (lines 15-16 of claim 6)? Specifically what elements are being transported or transmitted? Where are they being transported or transmitted to? The phraseology must either be amended to be in accordance with accepted meaning or replaced with more appropriate terminology --bearing against--, --supporting thereon--, --receiving therein--, etc. as applicable.

It must be specified if “at least one outer end of the pin” (line 11 of claim 6) is meant to refer to one of the previously recited “outer ends” (line 10 of claim 6) or to an additional end for claim clarity.

The term “the ends of the bearing” (line 10 of claim 6 lacks proper antecedent basis.

Appropriate correction is required.

For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- It unclear how “the third component is configured to selectively transmit a force to the pin for rotating the first and second boom components” (lines 17-19) structurally limits the claims. What is the structural configuration being claimed? It appears that broadly read any solid object is “configured” to selectively transmit a force as claimed since any solid object can inherently be acted upon and transmit a force. Applicant must amend the claim such to be clear specifically what additional structure, if any, is required by the limitation. The current phraseology is incomplete for omitting essential elements and/or essential structural cooperative relationships of elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. For purposes of examination the recitation is taken to read broadly on any solid third component. Furthermore, the functional recitation is presumed to be inherently capable of the prior art structure noted below, in accordance with MPEP 2112.01 and 2114 and as follows:
 - MPEP §2112.01 (I) states “When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent... [and] a *prima facie* case of either anticipation or obviousness has been established” (emphasis added);

- MPEP §2114 states “Apparatus claims must be structurally distinguishable from the prior art... [and the] Manner of operating the device does not differentiate apparatus claim from the prior art... [and a] claim containing a ‘recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus’ if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)” (emphasis in original).
- “Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludke*, *supra*. Whether the rejection is based on ‘Inherency’ under 35 USC 102, on ‘*prima facie* obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972)” (emphasis added) *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
- “Apparatus must be distinguished from the prior art in terms of structure rather than function.” *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429, 1431-32 (Fed.Cir.1997)

- “Apparatus claims cover what a device is, not what a device does.” See *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)
- “[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” (emphasis added) *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971), and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- “[I]t is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.”

(emphasis added) *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

- "Contrary to appellant's reasoning, after the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on... Here, appellant's burden before the board was to prove that Donley's structure does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden, it did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- "Spada was reasonably required to show that his polymer compositions are different from those described by Smith. This burden was not met by simply including the assertedly different properties in the claims. When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).
- MPEP §716.01(c) (II) states "The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)."

Claim Rejections - 35 USC § 102

Claims 6-9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramun USPN 6994284.

Regarding claim 6, Ramun discloses (figs.2-4) a construction machine comprising a frame (12), a first boom component (24) having a first end (**end of 28 connected rotatably connected to 12**) rotatably mounted to the frame of the machine, a second boom component (28) articulated to a second end (**end of 14 connected rotatably to 28**) of the first boom component by a bearing (214), the bearing having a bearing tube (214) having an internal (**internal diameter of 214**) and external diameter (**external diameter of 214**); a pin (34) extending in the direction of a swiveling axis (**swiveling axis of 214**) of the bearing and borne in the bearing tube, wherein the pin has outer ends (**outer ends of 34**) protruding from the ends of the bearing tube; a third component (19) borne on at least one outer end of the pin, the external diameter of the bearing tube is greater than an external diameter of the pin; and the first component and the second component are both borne alongside each other on the external diameter of the bearing tube, the third component is configured to selectively transmit a force to the pin for rotating the first and second boom components (when 19 is raised or lowered via 22 to rotate the assembly), the third component being rotatable with respect to the pin and the first and second boom components.

Regarding claim 7, the construction machine further comprises a first set of bearing points (**points of 260 contacting middle of 214**) on the first boom component located in contact with the middle of the bearing tube; a second set of bearing points (**points of 260 contacting outer portions of 214**) of the second boom component located immediately outside of adjacent

to the bearing points of the first boom component, and the bearing point of both the first and second boom component being slidable on the external diameter of the bearing tube.

Regarding claim 8, the bearing points of the first and second components are fitted with guide bushings (260).

Regarding claim 9, the second boom component is inserted over (over when viewed from the axial direction) the first boom component such that the second boom component is supported by and moves with the first boom component (when entire assembly is raised or lowered), the second boom component having a first pivotal connection at the bearing with the first boom component and third component having an adjustment cylinder (outer cylinder of 38) and a second pivotal connection connected to a second adjustment cylinder (second cylinder of 38), wherein the second boom component is rotatable with respect to the first boom component and pin by movement of either cylinder.

Regarding claim 12, a ring (**32 and/or 246 and/or 248**) having a locking connector (screw connectors shown extending therethrough but without reference character) is inserted over both ends of the pin and maintains axial alignment of the components located therebetween.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramun USPN 6994284, in view of Mieger, 6,385,872.

Regarding claim 11, Ramun, as discussed, fail to disclose the external diameter of a mid-section of the pin being less than an external diameter at either end of the pin. Mieger teaches, in Figure 8, a mid-section of a pin being less than an external diameter at either end of the pin to increase the volume of the grease reservoir thus providing more grease in a pivot connection. Therefore, as taught by Mieger, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place an annular groove in a mid-section of the pin such that the external diameter of the mid-section of the pin is less than an external diameter at either end of the pin in Ramun to increase the volume of the grease reservoir thus allowing for more storage of grease in the pivot connection.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Allowable Subject Matter

Claims 10 and 13 (as best understood by the examiner, see 35 U.S.C. 112 rejection above) would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and the claim objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

June 25, 2010

/Victor MacArthur/
Primary Examiner, Art Unit 3679